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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,375	07/10/2001	Martin S. Niles		8831

7590 12/18/2002
Rodman & Rodman
7 South Broadway
White Plains, NY 10601

EXAMINER

FULLER, ERIC B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,375

Applicant(s)

NILES, MARTIN S.

Examiner

Eric B Fuller

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US 5,997,894) in view of Detrick (US 5,599,374).

Blum teaches a process of coating electrical wires with a material so that they are protected from animal attacks (column 4, line 40). Applicant, on page 9 of the specification, defines "dielectric material" to be "any material... suitable for providing insulating capability between electrified wires and an electrical ground". Blum teaches the coating is non-conductive (column 4, line 34), and therefore reads on the applicant's definition of dielectric material. Blum further teaches that the coating is not only applied to the wire, but to any object subject to attack by animals (column 4, lines 46-50). One of ordinary skill would recognize that since the wire is subject to attack by animals, the structure supporting the wire would be as well. Therefore it would be obvious to coat the structure supporting the wire with the coating of Blum as well as the wire. The reference also teaches that the composition is mostly comprised of wax and/or oil being mixed with polymers and is applied by methods known in the art (column 3, lines 58-67; column 4, lines 1-10). The reference is silent to what these known methods are.

However, Detrick teaches that it is known to apply coatings of polymeric hydrocarbons, petroleum-based wax, or combinations of high viscosity polymeric paraffinic oil plus polyethylene by converting the material into a hot melt and spraying it on the substrate (column 1, lines 45-50). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply the coating of Blum by the spray method of Detrick, as it is a known method for applying the polymeric/oil coating. By doing so, applicant would have a reasonable expectation of success. To continue spraying until a desired thickness is achieved would also have been obvious. This reads on the limitations of claims 1, 2, 6, 8, 12, and 15.

As to claims 3, 5, 7, 10, 11, 13, and 14, to apply the coating before or after the installation of the wire to the support and with or without the wire being energized are all obvious variations of each other. To use either choice would have been obvious with the expectation of achieving similar results, as the effectiveness of the coating is not influenced by these parameters. Additionally, in cases where the wire is not energized, the electric potential between the support and the wire must be zero. Therefore, the potential has been evaluated before the application of the coating.

As to claims 4 and 9, the reference is silent on how the thickness of the coating is determined. However, it is taught that the coating must have a desired hardness and be non-conductive. Therefore, to choose a thickness that has the desired hardness and has zero conductivity (applicant's "desired dielectric insulating capability") would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Response to Arguments

In response to applicant's argument that Detrick is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Blum teaches a coating that mostly comprises wax and/or oil being mixed with polymers, but is silent to the application method. It is specifically taught to use a method known in the art. Therefore, one would be motivated to look for a method where wax and/or oils are being mixed with polymers and applied to a substrate. Detrick would fulfill this search by teaching that it is known to apply coatings of polymeric hydrocarbons, petroleum-based wax, or combinations of high viscosity polymeric paraffinic oil plus polyethylene by converting the material into a hot melt and spraying it on the substrate. Therefore, Detrick is reasonably pertinent to the particular problem that is of concern.

Applicant argues that there is no teaching or suggestion in Blum that would lead a person of ordinary skill to apply the compositions on high voltage transmission lines. This argument is moot as the claims are only drawn to applying the composition to electrified wires, not high voltage transmission lines. Blum explicitly teaches usage on electrified wires.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached at (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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EBF

December 16, 2002



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SUPERVISORY PATENT EXAMINER
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